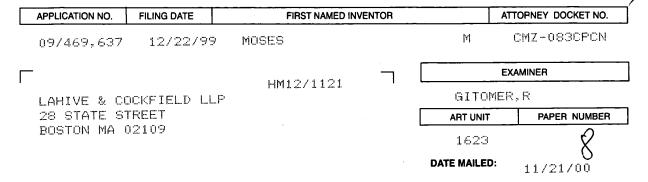


UNITED STATES PARTMENT OF COMMERCE Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231



Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/469,637	Applicant(s	eant(s) Moses et al.		
	Examiner Ralph Gitomer		Group Art Unit 1623		
Responsive to communication(s) filed on <u>Dec 22,</u>	1999			·	
This action is FINAL .					
□ Since this application is in condition for allowance in accordance with the practice under <i>Ex parte Q</i>			on as to the me	rits is closed	
A shortened statutory period for response to this act is longer, from the mailing date of this communication application to become abandoned. (35 U.S.C. § 133 37 CFR 1.136(a).	on. Failure to respond with	hin the perio	d for response v	will cause the	
Disposition of Claims					
X Claim(s) <u>1-121</u>		is/are	pending in the	application.	
	i(s)is/a			are withdrawn from consideration.	
Claim(s)					
Claim(s)					
	is			:0.	
X Claims <u>1-121</u>					
 The proposed drawing correction, filed on The specification is objected to by the Examin The oath or declaration is objected to by the E Priority under 35 U.S.C. § 119 Acknowledgement is made of a claim for fore All Some* None of the CERTIFIE received. 	er. Examiner. ign priority under 35 U.S.(C.§119(a)-			
received in Application No. (Series Code			—		
received in this national stage application *Certified copies not received:				·	
Acknowledgement is made of a claim for dom	estic priority under 35 U.S	S.C. § 119(e	e).		
Attachment(s)					
Notice of References Cited, PTO-892					
☐ Information Disclosure Statement(s), PTO-144	9, Paper No(s).				
 Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review 	PTO-948				
 Notice of Informal Patent Application, PTO-15 					
SEE OFFICE A	CTION ON THE FOLLOWING	G PAGES			

•- , +

5

10

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, 47, 48, 50-55, 64-103, drawn to a method for facilitating a diagnosis, classified in class 435, subclass 6.
- II. Claims 35-46, 49, 104-114, drawn to a method for facilitating the prognosis of prostate disorders, classified in class 435, subclass 6.
- III. Claims 56-63, 115-121, drawn to a kit for facilitating diagnosis, classified in class 435, subclass 975.

The inventions are distinct, each from the other because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as being employed by people who already have a diagnosis. See MPEP § 806.05(d).

20

25

Inventions I and II vs. III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another

-2-

and materially different process. (MPEP § 806.05(e)). In this case the method could be practiced by hand.

-3-

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to 10 be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

20

This application contains claims directed to the following patentably distinct species of the claimed invention: Applicants are required to elect a single condition and a single enzyme each of which is specific, substantial and credible.

25

2

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

-4-

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or 20 identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15

10

5

6. G

5

10

15

20

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (703) 308-0732. The examiner can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm. The examiner can also be reached on alternate Mondays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist can be reached on (703) 308-1701. The fax phone number for this Art Unit is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1234. For 24 hour access to patent application information 7 days per week, or for filing

applications electronically, please visit our website at www.uspto.gov and click on the button **%**Patent Electronic Business Center**%** for more information.

Rectorio

. - 5 -

Ralph Gitomer Primary Examiner Group 1623

> RALPH GITOMER PRIMARY EXAMINER GROUP 1200